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Incyte Genomics, Inc.
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Palo Alto, CA 94304

In re Application of TANG et al	:	
U.S. Application No.: 09/787,678	:	DECISION ON PETITION
Int. Application No.: PCT/US99/22027	:	
Int. Filing Date: 22 September 1999	:	UNDER 37 CFR 1.47(a)
Priority Date: 22 September 1998	:	
Attorney Docket No.: PF-0595 USN	:	
For: HUMAN CHAPERONE PROTEINS	:	

This is in response to applicant's "Petition Under 37 C.F.R. §1.47(a)" filed 18 January 2002, requesting that the present application be accepted for United States national stage processing without the signature of one of the joint inventors.

BACKGROUND

On 22 September 1999, applicant filed international application PCT/US99/22027, which claimed priority of an earlier United States application filed 22 September 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 18 April 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 March 2001.

On 20 March 2001, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 19 April 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 January 2002, applicant filed the present petition under 37 CFR 1.47(a) along with a declaration executed by five of the six inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by five of the six inventors, each on his/her own behalf and on behalf of the nonsigning inventor Sajeew Batra. The declaration lists the fourth inventor's name as "Chandra Arvizu", while the international application lists the fourth inventor's name as "Chandra Patterson". The DO/EO/US has not received a Notification of the Recording of a Change (Form PCT/IB/306) which indicates a change in the fourth inventor's name.

MPEP 605.04(c) states in relevant part,

In cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. . . . The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicant has not filed a petition under 37 CFR 1.182 along with the required fee and either an affidavit signed with both names and setting forth the procedure whereby the change of name was effected or a certified copy of a court order.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In the present case, the petition states that inventor Batra cannot be located. It is noted that the petition does not allege that Batra refuses to join in the application. The petition states that a complete copy of the application papers was sent to Batra at his last known address on

18 September 2001 and that the correspondence was successfully delivered. (See affidavit of Nancy Lares Glynn). In addition, the petition states that approximately five telephone calls were made to Batra and were not answered. (See Glynn's affidavit). Furthermore, the petition states that an additional telephone call to Batra revealed that the telephone number had been temporarily disconnected. (See Glynn's affidavit). However, the submitted evidence does not sufficiently demonstrate that Batra cannot be located. Specifically, the fact that the 18 September 2001 letter was successfully delivered contradicts the assertion that Batra cannot be located. Also, petitioner has not provided any details of additional attempts to locate Batra e.g. by obtaining a forwarding address if there is reason to believe the current address is no longer valid and by searching telephone books and online directories. Moreover, petitioner has not stated that any attempts were made to contact Batra by electronic mail and through his former coworkers, friends, and family members. Additionally, petitioner has not mentioned any attempt to determine whether the temporary disconnection of Batra's telephone is still in effect. Because petitioner has not adequately illustrated that a diligent effort was made to find Batra, it would be unreasonable to conclude at the present time that Batra cannot be located.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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